

#4
JSM
10/24/02IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE

APPLICANT: Wyatt ATTY. DOCKET NO.:MCO-P-00-002

SERIAL NO.: 09/544,510 GROUP ART UNIT: 2172

FILING DATE: Apr. 6, 2000 EXAMINER: Ly

TITLE: "A METHOD AND SYSTEM FOR CREATING A WEBSITE FOR A
HEALTHCARE PROVIDER"Asst. Commissioner for Patents
Washington, DC 20231

RECEIVED

OCT 16 2002

RECEIVED

OCT 15 2002

SIR:

Technology Center 2100

Technology Center 2600

This Response is submitted in response to the Office Action dated July 3, 2002. In the Office Action, the Patent Office rejected Claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,343,271 to Peterson et al. in view of U.S. Patent No. 6,195,651 to Handel et al.

By the present Response, Applicant respectfully submits that the rejections are improper and the application is currently in condition for allowance for the reasons that follow. Notice to that effect is requested.

With respect to the rejection of independent Claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,343,271 to Peterson et al. in view of U.S. Patent No. 6,195,651 to Handel et al., the Patent Office alleges:

Peterson discloses providing a remote server having a database; accessing the remote server via a first remote computer on a computer network. Peterson does not explicitly indicate, "creating a website having a first web page by the remote computer on the remote server

wherein the website relates to a healthcare provider providing healthcare services; assigning pre-defined attributes to the website that uniquely identify the website; and linking to the database wherein the database is searchable via a search engine wherein the search engine searches the database for specific attributes.

Handel et al., the Patent Office alleges, disclose web pages, healthcare services, database and search engines. The Patent Office further states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Peterson* with the teachings of *Handel* so as to obtain a method for creating websites for individuals, healthcare facilities and other healthcare providers because the combination would provide a benefits system which allows practitioners to access information on-line, and healthcare providers have access to patient information in preparation for consulting with a patient and the processing system comprising the Internet or other WANS or direct dial access may be used to support the communications infrastructure in the healthcare provider providing healthcare services environment.

Peterson et al. merely disclose a system for reviewing and adjudicating health care provider payment requests wherein a health care benefit component stores patient and benefit information by a health care provider and allows access to stored information. *Peterson et al.* do not disclose creation of a website on a remote server using a remote computer wherein the website has a first web page and wherein the website relates to a healthcare provider providing healthcare services. Additionally, *Peterson et al.* do not disclose linkage of the website to a database wherein the database is searchable via a search engine wherein the search engine searches the database for specific attributes.

Applicant asserts that *Handel et al.* does not disclose, teach, or suggest the creation of a website which relates to a healthcare provider providing healthcare services. Accordingly, no motivation exists for combining the teaching of *Handel et al.* with that of *Peterson et al.*.

With respect to the rejection of Claim 15, the Patent Office alleges that *Peterson et al.* disclose a remote server having a database on a computer network and a first remote computer connected to the remote server via the computer network. Additionally, the Patent Office alleges:

Peterson et al. does not explicitly indicate a website having a web page which is created on the remote server via the remote computer using pre-defined information contained on the remote server wherein the website relates to a first healthcare provider providing healthcare services and further wherein the website is stored on the database; and pre-defined attributes associated with the website for uniquely identifying the website in the database.

Handel et al. merely disclose web pages and databases. However, the Patent Office asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of *Peterson et al.* with *Handel et al.* to result in a system for creating websites for healthcare providers as defined in Claim 15.

However, neither *Peterson et al.* nor *Handel et al.*, either singly or in combination, disclose or suggest a system for creating websites for healthcare providers including a remote server having

a database therein on a computer network; a first remote computer connected to the remote server via the computer network wherein a website having a web page is created on the remote server via the remote computer using pre-defined information contained on the remote server wherein the website relates to a first healthcare provider providing healthcare services and further wherein the website is stored on the database; and predefined attributes associated with the website for uniquely identifying the website in the database.

As stated above, *Handel et al.* do not even remotely teach or suggest creation of websites for healthcare providers and/or healthcare services. Thus, no motivation exists for the combination of the teaching of *Peterson et al.* and the teaching of *Handel et al.*.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the reference in its entirety, would have been obvious to one of

ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Peterson et al.* and *Handel et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Peterson et al.* and/or *Handel et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

The Patent Office alleges that one skilled in the art would recognize that the system of *Peterson et al.* for electronically reviewing and adjudicating medical insurance claims could be modified in light of *Handel et al.* to create a method and system for creating a website for a healthcare provider. Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined

limitations of Applicant's method and system to deprecate the claimed invention. By admission of the Patent Office, Peterson et al. fail to even remotely teach or suggest the claimed elements of Applicant's invention.

Additionally, Handel et al., while generally disclosing common elements such as web pages, databases, and search engines, do not enable one of ordinary skill in the art to create the claimed invention for a method and system for creating a website for a healthcare provider. Even if the references recite common elements, hindsight reconstruction of Applicant's invention is impermissible.

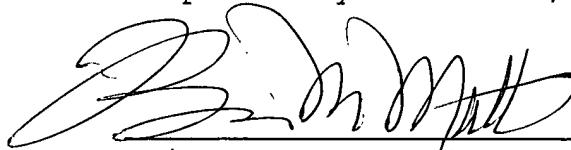
In view of the foregoing remarks, Applicant respectfully submits that the rejections of Claims 1-21 under 35 U.S.C. §103(a) are overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-14 depend from Claim 1; and Claims 16-21 depend from Claim 15. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional steps and elements of Applicant's method and system, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain, Applicant

urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

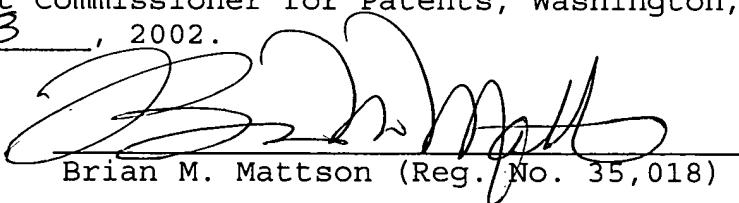


(Reg. No. 35,018)

Brian M. Mattson
ATTORNEY FOR APPLICANT
Patents+TMS
A Professional Corporation
1914 North Milwaukee Ave.
Chicago, IL 60647
(773) 772-6009

CERTIFICATE OF MAILING

I hereby certify that this **RESPONSE** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D. C. 20231 on October 03, 2002.



Brian M. Mattson (Reg. No. 35,018)